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MINTZ, LEVIN, COHN, FERRIS, GLOVSKY AND POPEO, P.C  
ONE FINANCIAL CENTER  
BOSTON MA 02111

**MAILED**

**MAR 01 2010**

**OFFICE OF PETITIONS**

In re Application of	:	
Schrepfer et al.	:	ON REQUEST FOR
Application No. 09/980661	:	RECONSIDERATION OF
Filing or 371(c) Date: 10/02/2003	:	PATENT TERM ADJUSTMENT
Attorney Docket Number:	:	
24334-001	:	

This is a decision on the "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(b)," filed September 21, 2009.

The application for patent term adjustment ("PTA") under 37 CFR 1.705(b) is **GRANTED TO THE EXTENT INDICATED.**

The Determination of Patent Term Adjustment mailed September 1, 2009 indicated a patent term adjustment to date of 598 days. Applicants petition for reconsideration of the patent term adjustment calculation from 598 days, as calculated by the Office, to 1186 days. Applicants request this correction based upon (1) an assertion that the Office erred in failing to calculate a delay of 51 days and (2) on the basis that the Office will take in excess of three years to issue this patent.

As to (1) indicated above, review of the record reveals that, as indicated by applicants, the Office neglected to assess a reduction of 51 days in accordance with 37 CFR 1.704(b) in connection with the reply to the Notification mailed May 12, 2003. The reduction commenced August 13, 2003, the day after the date that is three months after the date that the Notification was mailed, and ended October 2, 2003, the date that a reply to the Notification was filed.

In this regard, the request for reconsideration of patent term adjustment under 37 CFR 1.705(b) is **GRANTED.** The total applicant delay is increased from 196 days to 247 days.

As to (2) indicated above, applicants argue that the application is entitled to additional adjustment pursuant to 37 CFR 1.702(b), as it relates to the Office's failure to issue the patent within 3 years.

In this regard, the request for reconsideration of patent term adjustment under 37 CFR 1.705(b) is **DISMISSED as PREMATURE** insofar as it relates to adjustment under 37 CFR 1.702(b).

As to the Office's failure to issue the patent within 3 years of the filing date, knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentee is entitled to for Office failure to issue the patent within 3 years. See § 1.702(b). (This is true even where a request for continued examination (RCE) was filed). The computer will not undertake the § 1.702(b) calculation until the actual date of issuance of the patent has been determined. Likewise, the computer will not calculate any further Office delay under § 1.702(a)(4) or applicant delay under § 1.704(c)(10) until the actual date of issuance of the patent has been determined. As such, the Office can not make a determination on the correctness of the patent term adjustment until the patent has issued.

Requesting reconsideration of the patent term adjustment to be indicated on the patent under 37 CFR 1.705(b) based on the initial determination of patent term adjustment and a projected issuance date of the patent (or even the filing date of the request for continued examination) is premature. Accordingly, it is appropriate to dismiss as premature such a request.

Rather than file an application for patent term adjustment under 37 CFR 1.705(b) contesting the 37 CFR 1.702(b) calculation at the time of the mailing of the notice of allowance, applicant is advised that they may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term adjustment pursuant to 37 CFR 1.705(d). As the USPTO does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent. However, as to all other bases for contesting the initial determination of patent term adjustment received with the notice of allowance, applicant must timely file an application for patent term adjustment prior to the payment of the issue fee<sup>1</sup>.

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e) for consideration of the application for patent term adjustment under 37 CFR 1.705(b).

Any request for reconsideration of the patent term adjustment indicated on the patent, including any request as it relates to the Office's failure to issue the patent within 3 years of the filing date, must be timely filed within 2 months after issuance pursuant to 37 CFR 1.705(d) and **must** include payment of the required fee under 37 CFR 1.18(e).

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<sup>1</sup> For example, if applicant disputes both the calculation of patent term adjustment under 37 CFR 1.702(a)(1) for Office failure to mail a first Office action or notice of allowance not later than fourteen months after the date on which the application was filed and under 37 CFR 1.702(b) for Office failure to issue a patent within three years of the actual filing date of the application, then applicant must still timely file an application for patent term adjustment prior to the payment of the issue fee to contest the calculation of Office delay in issuing a first Office action or notice of allowance. See 37 CFR 1.705(b) and 35 U.S.C. 154(b)(3)(B). A dispute as to the calculation of the § 1.702(a)(1) period raised on request for reconsideration of patent term adjustment under 37 CFR 1.705(d) will be dismissed as untimely filed.

The Office of Data Management has been advised of this decision. This application is being referred to the Office of Data Management for issuance of the patent.

Telephone inquiries specific to this matter should be directed to Attorney Derek Woods at (571) 272-3232.

*/ALESIA M. BROWN/*

Alesia Brown  
Petitions Attorney  
Office of Petitions  
Office of the Deputy Commissioner  
for Patent Examination Policy

Enclosure: Adjusted PAIR Calculation

Day : Sunday  
Date: 2/28/2010

# PALM INTRANET

Time: 17:20:52

PTA Calculations for Application: 09/980661			
Application Filing Date:	10/02/2003	PTO Delay (PTO):	794
Issue Date of Patent:		Three Years:	0
Pre-Issue Petitions:	0	Applicant Delay (APPL):	196
Post-Issue Petitions:	0	Total PTA (days):	547
PTO Delay Adjustment:	-51		

File Contents History					
Number	Date	Contents Description	PTO	APPL	START
88	02/28/2010	ADJUSTMENT OF PTA CALCULATION BY PTO		51	
80	09/01/2009	MAIL NOTICE OF ALLOWANCE	18		69
79	08/20/2009	ISSUE REVISION COMPLETED			
78	07/28/2009	ALLOWED CASE RETURNED TO THE EXAMINER FOR CLERICAL PROCESSING			
77	07/28/2009	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			
76	07/28/2009	DOCUMENT VERIFICATION			
75	01/15/2004	REFERENCE CAPTURE ON IDS			
74	01/15/2004	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
73	07/17/2009	NOTICE OF ALLOWABILITY			
70	05/13/2009	DATE FORWARDED TO EXAMINER			
69	04/14/2009	RESPONSE AFTER NON-FINAL ACTION		23	67
68	04/14/2009	REQUEST FOR EXTENSION OF TIME - GRANTED			
67	12/22/2008	MAIL NON-FINAL REJECTION			
66	12/21/2008	NON-FINAL REJECTION			
58	10/08/2008	DATE FORWARDED TO EXAMINER			
57	10/01/2008	AMENDMENT SUBMITTED/ENTERED WITH FILING OF CPA/RCE			
56	10/08/2008	DATE FORWARDED TO EXAMINER			
55	10/01/2008	REQUEST FOR CONTINUED EXAMINATION (RCE)		4	51
54	10/08/2008	DISPOSAL FOR A RCE / CPA / R129			
53	10/01/2008	REQUEST FOR EXTENSION OF TIME - GRANTED			
52	10/01/2008	WORKFLOW - REQUEST FOR RCE - BEGIN			

51	06/27/2008	MAIL FINAL REJECTION (PTOL - 326)			
50	06/23/2008	FINAL REJECTION			
48	04/10/2008	DATE FORWARDED TO EXAMINER			
47	03/19/2008	RESPONSE AFTER NON-FINAL ACTION		141	42
46	03/19/2008	REQUEST FOR EXTENSION OF TIME - GRANTED			
45	02/20/2008	MISCELLANEOUS INCOMING LETTER			
44	01/24/2008	MAIL NOTICE OF INFORMAL OR NON-RESPONSIVE AMENDMENT			
43	11/05/2007	DATE FORWARDED TO EXAMINER			
42.1	10/30/2007	INFORMAL OR NON-RESPONSIVE AMENDMENT AFTER EXAMINER ACTION			
42	10/30/2007	RESPONSE AFTER NON-FINAL ACTION			
41	10/01/2007	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
39	08/09/2007	MAIL NON-FINAL REJECTION			
38	08/06/2007	NON-FINAL REJECTION			
36	05/31/2007	MISCELLANEOUS INCOMING LETTER			
35	01/15/2004	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
34	01/15/2004	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
33	05/23/2007	DATE FORWARDED TO EXAMINER			
32	05/15/2007	RESPONSE AFTER NON-FINAL ACTION		28	30
31	05/15/2007	REQUEST FOR EXTENSION OF TIME - GRANTED			
30	01/17/2007	MAIL NON-FINAL REJECTION	776		10
29	01/08/2007	NON-FINAL REJECTION			
28	07/28/2006	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
27	08/02/2004	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
26	07/28/2006	REFERENCE CAPTURE ON IDS			
25.7	07/28/2006	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
25	07/28/2006	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
24	06/26/2006	CASE DOCKETED TO EXAMINER IN GAU			
23	08/02/2004	REFERENCE CAPTURE ON IDS			
22.7	08/02/2004	INFORMATION DISCLOSURE STATEMENT (IDS)			

		FILED			
22	08/02/2004	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
21	11/09/2004	TRANSFER INQUIRY TO GAU			
20	06/17/2004	REFERENCE CAPTURE ON IDS			
19.7	06/17/2004	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
19	06/17/2004	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
18	06/08/2004	MAIL-PETITION DECISION - DISMISSED			
17	06/04/2004	PETITION ENTERED			
16	03/03/2004	REFERENCE CAPTURE ON IDS			
15.7	03/03/2004	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
15	03/03/2004	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
14	01/16/2004	REFERENCE CAPTURE ON IDS			
13.7	12/10/2003	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
13	12/10/2003	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
12	01/16/2004	IFW TSS PROCESSING BY TECH CENTER COMPLETE			
11	12/28/2003	CLEARED BY OIPE CSR			
10	10/02/2003	371 COMPLETION DATE			
9	11/19/2003	APPLICATION DISPATCHED FROM OIPE			
8	11/19/2003	NOTICE OF DO/EO ACCEPTANCE MAILED			
7	10/02/2003	ADDITIONAL APPLICATION FILING FEES			
6	10/02/2003	A STATEMENT BY ONE OR MORE INVENTORS SATISFYING THE REQUIREMENT UNDER 35 USC 115, OATH OF THE APPLIC			
5	10/02/2003	DRAWING PRELIMINARY AMENDMENT			

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#### EXPLANATION OF PTA CALCULATION

#### EXPLANATION OF PTE CALCULATION

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